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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78811559
Applicant	Seacret International LTD
Applied for Mark	SEACRET
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Seacret International LTD.

Serial No. 78811559

Filed: February 9, 2006

Mark: Stylized SEACRET

**TRADEMARK LAW OFFICE: 113**

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**REPLY IN SUPPORT OF APPLICANT’S APPEAL BRIEF**

Applicant incorporates each of the Arguments of Applicant’s Appeal Brief as if fully set forth herein. Applicant, however, wishes to reply to a few particular points raised by the Examining Attorney in his appeal brief.

**Similarity of Sound**

The Examining Attorney refers to *In re White Swan Ltd.* to argue similarity of sound may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d at 1535. However, the Examining Attorney fails to indicate that the Trademark Trial and Appeal Board further stated in *In re White Swan Ltd.* that “In appropriate cases, a finding of similarity as to any one factor (sight, sound or meaning) alone ‘may be sufficient to support a holding that the marks are confusingly similar.’” (Emphasis Added). Accordingly, it is

important to consider whether this is an appropriate case for finding sound alone is sufficient to support a holding of confusingly similar.

In order to determine whether sound alone is appropriate, the manner in which these goods are purchased is a significant factor. Specifically, “Any similarity in pronunciation, that is, that the marks are sound-alikes, is, however, minimized when, as here, the product is often purchased in a self-service cosmetics department and not by request to a salesclerk.” *See La Maur, Inc. v. Revlon, Inc.*, 245 F. Supp 839, 842 (D. Minn. 1965). This is exactly what we have in the present case. Registrant’s products are purchased in self-service cosmetic departments and not requested to a salesclerk. Further, Applicant’s goods are sold off the shelf in kiosks or online, which is a virtual shelf. Accordingly, Registrant’s and Applicant’s goods are not requested vocally, thereby minimizing the effect of any similarity of sound between these two marks. Sound alone in this case is not enough render the marks confusingly similar, and therefore other factors must be considered, such as sight and meaning. This comparison of each of these factors renders these marks distinguishable from each other and supports a finding of no likelihood of confusion.

In addition to a minimized effect regarding the similarity of sound, it is also understood that when a registered trademark has become associated in the public mind with a specific good, and the defendant does not manufacture that good and only uses its mark on products which no one would mistake for the specific goods, confusion is not found notwithstanding phonetic similarity of the two marks. *See Standard Brands, Inc. v. Eastern Shore Canning Co., Inc.*, 172 F.2d 144 (4th Cir. 1949) (Registered trade-mark “V-8” for combination of vegetable juices was not infringed by defendant's use of “VA” on tomato juice and lima beans, where “V-8” had become associated in public mind with specific combination of vegetable juices not

manufactured by defendant and no one would mistake defendant's tomato juice and lima beans for such combination of vegetable juices.) Registrant's marks for "Secret" have become associated in public mind with deodorant and odor fighting goods. In the present situation, Registrant has used "Secret" since 1956 all in association with deodorant. They have not veered from goods that relate to fighting odor for the last 57 years. In consumers' minds "Secret" is associated with deodorant. Applicant does not manufacture deodorant. Applicant's goods are very specific to skin care products and not deodorant. Accordingly, although the marks are similar in sound, considering the public mind association of "Secret" with deodorant, there is no likelihood of confusion.

### **Dominant Feature**

The Examining Attorney incorrectly asserts that Applicant argued that the mark is two words. Applicant stated in the Appeal Brief that the dominance was in the first syllable SEA with a wave design, and is a stylized form mark in drawing code 5. Applicant brings this point up for two purposes. The first purpose is to ensure that Applicant's argument is based on syllables of a single word, with the first syllable being dominant because the design feature of the mark is incorporated in the first syllable as previously stated. The second purpose is to reiterate the differences in the marks. As previously argue in the Appeal Brief, the appearance and connotation is difference due to the wave design incorporated into the first syllable of "SEACRET."

The Examining Attorney is correct that greater weight is often given to the dominant feature when determining whether marks are confusingly similar. *See In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751. The dominant feature of Applicants mark still remains the

stylized first syllable of SEACRET. Even though Applicant's and Registrant's marks may be similar in sound, Applicant has presented reasons previously as to why any weight given to the sound of the marks is minimized. This gives even greater weight to the appearance of the marks and the features that the Examining Attorney has called the slight visual stylization differences can no longer be considered slight. In fact, since these products are purchased by looking at the marks and not verbally requesting the same, the appearance is even more important. The stylization of the first syllable is unmatched by Registrant's SECRET marks and therefore no likelihood of confusion can be established.

### **Relatedness of Goods**

While it is appropriate for an Examining Attorney to utilize third-party registrations to demonstrate that certain goods are related, it is not evidence that the goods in this instance are related or ever will be related in any way. The Examining Attorney was correct in stating that each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). When looking at the facts of this case, the public mind associates SECRET with deodorant because Registrant has not bridged the gap to any other product over the last 57 years. The fact that other unrelated third parties may sell a line of goods that includes both Registrant's and Applicant's goods does not in any way prove that a consumer who has already solidified in his or her mind that SECRET is deodorant would be likely to be confused as to the source of SEACRET for Non-medicated skin care preparations, namely, moisturizers, facial cleansers, facial peels, masks, lotions, creams, scrubs, soaps, nail care preparations, hand creams, cuticle oils, aftershave. In fact it is difficult to see how that confusion would exist given the longtime usage of SECRET for

deodorant without bridging the gap into any non-medicated skin care preparations. Accordingly, while third-party registrations may at times indicate that goods can be related, it is not determinative that they are related. In this instance, taking into account all of the facts and the merits of each mark, it is clear that the goods are not related.

### **Conclusion**

The marks cited by the Examining Attorney are dissimilar in sight, meaning and connotation and the goods are dissimilar, in addition to the other arguments presented in the Appeal Brief, and therefore Applicant's mark is not likely to cause confusion with Registrant's cited marks. Accordingly, the Examining Attorney has not met the burden of proving that Applicant's use of the stylized ~~SECRET~~ mark for its identified services is likely to cause any confusion with the cited marks. For the reasons set forth herein, Applicant submits that its Mark is not confusingly similar to the cited marks and the Examining Attorney's decision should be reversed and Applicant's application passed to publication.

Respectfully submitted,  
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